

Appl. No. 10/708,304
Amdt. dated 20 March 2006
Reply to Office action of 20 September 2005

Amendments to the Drawings:

The four attached replacement drawing sheets include Figures 1, 2, 3 and 4. These sheets replace the original single sheets 1-4 which included Figures 1-4. These sheets replace the originally submitted drawing sheets which were transmitted via the USPTO EFS electronic filing system that altered the resolution of the original drawing images. No other changes have been made and no new matter has been added.

Attachments: Four Drawing Replacement Sheets

Four Originally Submitted Drawing Sheets

REMARKS / ARGUMENTS

Claims 1-46 are pending in this application. Claims 1-46 have been amended to delete brackets inserted by the USPTO EFS electronic filing system. Claims 1-46 will still be pending after entry of this response.

In section 1 of the September 20, 2005 office action, the Examiner has objected to the abstract because it does not commence on one page and because it includes legal phraseology. Applicants apologize for any formatting or typographical errors as it appears that the errors resulted from the USPTO EFS electronic filing system (version 1.1.1) conversion of the application files to USPTO standards on the date of submission. Much of the spacing, punctuation and the quality of the drawings were affected. Applicants have submitted a replacement abstract with typographical corrections on a single page.

Similarly, in section 2 of the September 20, 2005 office action, the Examiner has objected to the use of quotations throughout the specification. These double quotations were inserted by the EFS filing system and do not appear in Applicants' copies. Regardless, Applicants have submitted the requested replacement paragraphs of the specification.

Again, in section 3 of the September 20, 2005 office action, the Examiner has objected to the use of informalities instead of claim numbering. Again, these bracketed numbers were inserted during the USPTO EFS electronic submission process as a requirement for the filing. Applicants have submitted a replacement listing of the claims along with a version showing the changes made.

Appl. No. 10/708,304
Amdt. dated 20 March 2006
Reply to Office action of 20 September 2005

And again, in section 4 of the September 20, 2005 office action, the Examiner has objected to the use of informalities, specifically punctuation errors. Applicants have resubmitted the original listing of Applicant's claims before they were altered by the USPTO EFS electronic filing system instead of claim numbering. Again, these bracketed numbers were inserted during the USPTO EFS electronic submission process as a requirement for the filing. As previously stated, Applicants have submitted a replacement listing of the claims along with a version showing the changes made.

In section 5 of the September 20, 2005 office action, the Examiner has objected to the drawings because they are not clear. Applicants' submitted drawings were also altered by the USPTO EFS filing system to make these drawings comply with the filing requirements. Applicants have submitted four replacement drawing sheets showing the Figures 1-4 along with a version showing the originally filed drawings after those drawings were altered by the EFS filing system.

Approval of these replacement sheets in these four figures is requested. No new matter has been entered. The illustrated features are clearly disclosed in the specification and they are all clearly part of the disclosure.

The examiner has rejected claims 1-3, 6-13, 15-17, 19-22, 24-26, 29-36, 38-40, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,273,863 to Avni et al. The Applicant respectfully disagrees with the Examiner's characterization of this art and the Examiner's application of this art to Applicant's claim. In order to establish prima facie

Appl. No. 10/708,304
Amdt. dated 20 March 2006
Reply to Office action of 20 September 2005

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. 2143.03. Here, each and every limitation of independent claims 1 and 4 are not taught or suggested by Avni and therefore are not obvious under 35 U.S.C. 103 . Since there are limitations in Applicants' independent claims 1 and 24, then all of Applicants' claims that depend from independent claims 1 and 4 are also not obvious under 35 U.S.C. 103.

Further, in order to establish the obviousness of a claim, the Examiner must first consider the each and every claim as a whole. Second, the reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. Third, the reference must be viewed without the benefit of impermissible hindsight vision afforded by the claimed subject matter and fourth, reasonable expectation of success if the standard with which obviousness is determined. The Examiner has failed to establish meet these burdens and thus has failed to meet the standard for obviousness.

For example, Applicants' claims 1-46 involve either an alarming apparatus or a method for alarming or alerting the user to an excessive amount of impact. Avni does not teach or suggest the claimed subject matter; rather it describes a system limited to the rehabilitation of injuries to the lower extremities of a user. Specifically, Avni discloses a system that allows a user to monitor the weight bearing force on his or her lower extremity during the rehabilitation process. (Col. 3, lines 30-34). Further, the stated purpose of Anvi's disclosure is to encourage the patient to load the optimal target weight for the limb for which the weight bearing force is being measured. (Col. 3, lines 28-30). Applicant is unable to find any suggestion in Anvi of any

alarming feature which would alert a user when one or more threshold levels of force are reached upon impacts with the sole of a user's foot. Further, Avni describes measures the weight bearing force on a single limb rather than the impact force to encourage the patient to increase or decrease the weight bearing load on the limb for purposes of rehabilitating that limb. (Col. 6, lines 48-58).

M.P.E.P. 2141.02 states that "in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Here, the subject matter as a whole is would not have been obvious looking at Anvi because the advantages of the present invention could not have been met by reading Avni, and one skilled in the art would have been unable to practice the embodiments of the present invention by reading Avni. This section of the M.P.E.P. also states that "in determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole" and to do that one must "look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification..." Here, the Avni disclosure is directed entirely to the rehabilitation of a user's limb which teaches away from the subject matter of the present invention.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Here, there is no

Appl. No. 10/708,304
Amdt. dated 20 March 2006
Reply to Office action of 20 September 2005

suggestion or motivation to use Avni in such as way as to result in the present claimed subject matter. Second, there must be a reasonable expectation of success. There is no such expectation in Avni of success as to the presently claimed subject matter. Third, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. Again, there is no teaching or suggestion to make the claimed combination and no reasonable expectation of success in the prior art, thus the Examiner has failed to establish a prima facie case of obviousness.

The Applicants note that since independent claims 1 and 24 rejected under 35 U.S.C. § 103(a) are patentable, dependent claims 2-3, 6-13, 15-17, 19-22, 25-26, 29-36, 38-40, and 42-25 are patentable for at least the same reasons. M.P.E.P. 2143.03 states that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is also nonobvious.

The Examiner has also rejected claims 14, 18, 23, 37, 41 and 46 under 35 U.S.C. § 103(a) as being unpatentable in view of Avni in further view of Gray (U.S. Patent Number 5,357,696). This rejection is traversed for the reasons set forth above regarding claims 1 and 4.

Lastly, Applicants acknowledge that claims 4, 5, 27 and 28 are directed to allowable subject matter as they are also patentably distinguishable from the prior art.

For the above reasons, claims 1-46 in the application are now patentable over the references as well as any combination of them. Accordingly, the application is in condition for allowance and such action is respectfully solicited. Applicants believe that they have responded

Appl. No. 10/708,304
Amdt. dated 20 March 2006
Reply to Office action of 20 September 2005

to all the concerns raised by the Examiner, but if the Examiner has any questions about the present response, a telephone interview is requested.

In addition, a petition for extension of time under C.F.R. 1.136(a) is submitted along with the appropriate fee. No additional fees are due.

Respectfully submitted,

KEVIN GROLD, et al.

/MichaelPEddyPTO#42,505/

By: MICHAEL P. EDDY
Attorney for Applicant
Registration No. 42,505
Tel.: (858) 345-1098

LAW OFFICE OF MICHAEL P. EDDY
12526 High Bluff Drive, Ste. 300
San Diego, California 92130
Telephone: (858) 345-1098
Facsimile: (858) 777-5453